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**JAN 13 2006**

**OFFICE OF PETITIONS**

FAY KAPLUN & MARCIN, LLP  
150 BROADWAY, SUITE 702  
NEW YORK, NY 10038

In re Application of :  
McAlister, et al. : DECISION ON PETITION  
Application No. 10/764,619 :  
Filed: January 26, 2004 :  
Atty. Docket No.: 10121/00308 :

The above-identified application has been forwarded to the Office of Petitions for consideration of the "PETITION TO WITHDRAW HOLDING OF ABANDONED PATENT APPLICATION" filed July 8, 2005.

The petition under 37 CFR 1.181 to withdraw the holding of abandonment is hereby DISMISSED.

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.181." This is not a final agency decision.

This application was became abandoned November 4, 2004 for failure to timely submit a proper reply to the non-final Office action mailed August 3, 2004. The non-final Office action set a three month shortened statutory period of time for reply. Notice of Abandonment was mailed June 2, 2005.

Petitioners argue that the non-final Office action was "mailed to the wrong address and was never received by the Applicants." Petitioners further indicate that a search of applicants' file and docket records indicate the non-final Office action was not received. While a copy of the docket report is referenced as accompanying the instant petition, review of the application file does not reveal receipt of such.

In the absence of any irregularity in the mailing of the non-final Office action, there is a strong presumption that the non-final Office was properly mailed to practitioner at the address of record. This presumption may be overcome by a showing that the Notice was not in fact received. The showing required to establish non-receipt of an Office communication must include a statement from the practitioner stating that the Office communication was not

received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received. A copy of the docket record where the non-received Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement. See, MPEP 711.03(c). The showing outlined above may not be sufficient if there are circumstances that point to a conclusion that the Office communication may have been lost after receipt rather than a conclusion that the Office communication was lost in the mail.

Moreover, petitioners are advised that where an application becomes abandoned as a consequence of a change of correspondence address (the Office action being mailed to the old, uncorrected address and failing to reach the applicant in sufficient time to permit a timely reply), petitioners are required to establish that due care was taken to adhere to the requirement for prompt notification in each concerned application of the change of address (See, MPEP 601.03), and must include an adequate showing that a timely notification of the change of address was filed in the application concerned, and in a manner reasonably calculated to call attention to the fact that it was a notification of a change of address. See, MPEP 711.03(c).

Office records indicate the Office communication was properly mailed to the correspondence address of record at the time of mailing. Accordingly, there was no irregularity in mailing the Office communication on the part of the United States Patent and Trademark Office. Moreover, a review of the application file does not indicate that a change of correspondence address was submitted prior to the mailing of the non-final Office action.

#### **ALTERNATE VENUE**

Petitioners are strongly urged to consider filing a petition stating that the delay was unintentional. Petitioner's attention is directed to 37 CFR 1.137(b) which provides for the revival of an "unintentionally" abandoned application without a showing that the delay in prosecution or in late payment of an issue fee was "unavoidable". An "unintentional" petition under 37 CFR 1.137(b) must be accompanied by the required petition fee and reply.

The filing of a petition under 37 CFR 1.137(b) cannot be intentionally delayed and therefore must be filed promptly. A person seeking revival due to unintentional delay cannot make a statement that the delay was unintentional unless the entire delay, including the delay from the date it was discovered that

the application was abandoned until the filing of the petition to revive under 37 CFR 1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition for revival under 37 CFR 1.137(b).

Further correspondence with respect to this matter should be addressed as follows:

By mail:

**Mail Stop Petition**  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

By facsimile:

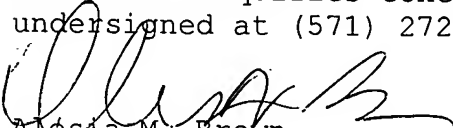
(571) 273-8300

By hand delivery:

U.S. Patent and Trademark Office  
Customer Window, **Mail Stop Petition**  
Randolph Building  
401 Dulany Street  
Alexandria, VA 22314

The requested change of correspondence address submitted July 8, 2005 has been entered into the record.

Telephone inquiries concerning this matter may be directed to the undersigned at (571) 272-3205.



Alesia M. Brown  
Petitions Attorney  
Office of Petitions